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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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03/13/2006

Zhuangrong Sun

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2320

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EXAMINER

CHU, YONG LIANG

ART UNIT

PAPER NUMBER

1626

MAIL DATE

DELIVERY MODE

11/18/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/541,058	Applicant(s) SUN ET AL.	
	Examiner YONG CHU	Art Unit 1626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 August 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 24-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 24-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claims 17-23 have been cancelled. Claims 24-30 are added. Therefore, Claims 24-30 are pending in this application, and are under examination on the merits.

Response to Amendment

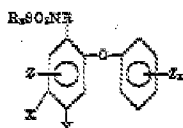
The Amendment by Applicants' representative Shannon D. Schemel dated on 08/07/2008 has been entered.

Response to Arguments

Argument/amendment over rejection of claims under 35 U.S.C. §102(b)

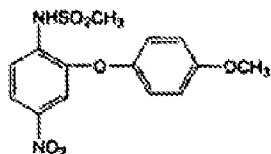
The argument and the Declaration under 37 CFR 1.132 filed 08/07/2008 are insufficient to overcome the rejection of claim 17 (now claim 24 after amendment) as set forth in the last Office action because:

1. Applicants' argue the wording "object to achieve a particular results does not disclose that the result has been achieved". This argument is not persuasive. The '597

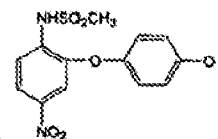


patent teaches a compound of the formula , wherein Z' is halogen, alkoxy, hydroxyl, etc., according to claim 1, and a method of using said compound as anti-inflammatory agents, see line 35-39, Column 1, and the abstract. Therefore, the term "object to" is used to suggest the utility of the instant invention, is not undue.

2. The cited compound 2-(4-methoxyphenoxy)-4-nitromethane-sulfonanilide

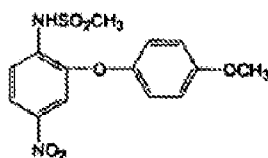


was labeled as a "starting material" to describe a fact of making



another compound 2-(4-hydroxyphenoxy)-4-nitromethane-sulfonanilide

in the specific context. It does not mean the compound the 2-(4-methoxyphenoxy)-4-nitromethane-sulfonanilide is solely used as a non-active intermediate, which is evidenced by the statement at lines 1-2, Column "The product shown in the following table are prepared from other compounds of the invention as described." The so called "starting material" is indeed another compound of the invention. In addition, the

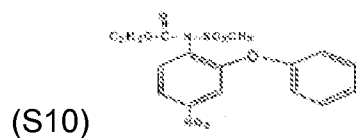


so called "starting material"

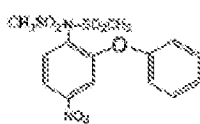
is encompassed by claim 1 of the '597

patent.

3. The 132 Declaration in Appendix D demonstrates that the two compounds



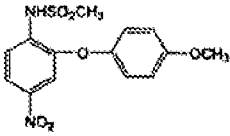
and (S11)

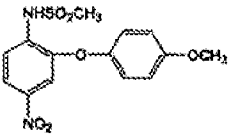


have no anti-inflammatory activity.

However, these two compounds are not relevant to the instantly cited compound because neither compound **S10** nor compound **S11** contains hydroxyl or alkoxyl group on the right-side phenyl ring, and neither compound **S10** nor compound **S11** is a

methane-sulfonanilide. Furthermore, Applicants's own data suggest the cited

 compound is active as an anti-inflammatory agent.

 4. The cited compound is specifically disclosed in the '597 patent, and is encompassed within claim 1. Though understanding the claim language may be aided by explanations contained in the written description, it is important not to import into a claim limitations that are not part of the claim. For example, a particular embodiment appearing in the written description may not be read into a claim when the claim language is broader than the embodiment." *Superguide Corp. v. DirecTV Enterprises, Inc.*, 358 F.3d 870, 875, 69 USPQ2d 1865, 1868 (Fed. Cir. 2004). A term should not be limited to **preferred embodiments** in the specification, see *E-Pass Technologies, Inc. v. 3Com Corporation*, 343 F.3d 1364, 1368, 67 USPQ2d 1947, 1949 (Fed. Cir. 2003). Also see MPEP§2110.01.

Therefore, the rejection is maintained.

Argument over rejection of claims under 35 U.S.C. §103(a)

The argument and Declaration under 37 CFR 1.132 filed 08/07/2008 are insufficient to overcome the rejection of claims 17-23 (now claims 24-30 after amendment) based upon 103(a) rejection as set forth in the last Office action based on the same analysis under 102(b). The additional references cited in the previous Office

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action are combined with the primary reference the '597 patent as whole render the instant application obvious. Therefore, the rejection is maintained.

Claim objection

Applicants have canceled the objected claims 17-23. Therefore, the objection is moot.

Specification

Applicants' amendment of the 1st paragraph of the specification obviates the objection.

Conclusion

- No claims are allowed.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Telephone Inquiry

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yong Chu whose telephone number is 571-272-5759. The examiner can normally be reached on 7:00 am - 3:30 pm EST. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph McKane can be reached on 571-272-0699. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Status information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only.

/Yong Chu/
Patent Examiner
Art Unit 1626

/Kamal Saeed/
Primary Patent Examiner
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